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514413-3802.1**REMARKS****I. STATUS OF THE CLAIMS**

It is believed that no fee is required for the consideration of this Amendment. If, however, a further fee is due, the Assistant Commissioner is authorized to charge such fee or credit any overpayment to Deposit Account No. 50-0320.

This Amendment cancels all the claims in favor of new claims 23 to 31, which were the claims under consideration at the time parent application SN: 09/499,997 was abandoned. Claims 32 and 33 have also been added which represented further limitations on the scope of the compounds of claim 23 and are supported by the examples cited in Table 1. Applicants have made these changes in order to advance prosecution and to find a reasonable compromise with the Examiner; these changes are not being made for reasons related to patentability. Claims 23-33 are now pending. No new matter has been added.

**II. ENTRY OF SUPPLEMENTAL DECLARATION**

This application was refiled in order to receive consideration of the Declaration by Dr. Menne (signed on 20 September 2002) which improperly was not considered by the Examiner (as indicated in his Advisory Action mailed 3 February 2003). This failure to consider the declaration was not well received by the applicants from a customer service standpoint as the supplemental declaration was previously submitted on 3 October 2002 as part of the response to a Non-Final rejection and there was no record of a telephone inquiry by the Examiner regarding the "missing" declaration which was clearly referred to in the response to the Non-Final rejection.

Copies of both declarations by Dr. Menne (dated 20 November 2001 and 4 September 2002) are being submitted with this preliminary amendment. Please contact the undersigned if any copy of the declaration is missing from this response.

**III. THE 35 U.S.C. §103(a) REJECTION HAS BEEN OVERCOME**

Claims 23-31 were rejected under 35 USC § 103(a) for allegedly being unpatentable over Levitt, US 4,892,946 or Shurter et al. EP 116 518 ("Shurter").

Although the supplemental declaration was not entered, it appeared that the Examiner did consider the supplemental declaration before preparing his remarks in the Advisory Action mailed on 3 February 2003. However, the comments made appear to indicate application of an

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improper standard with regard to the evidence of unexpected results proffered by the applicants in the declarations by Dr. Menne.

The evidence to show a superior property is not limited to any specific property. As stated in part in MPEP 716.02(a), section II - "Evidence of unobvious or unexpected advantageous properties, such as superiority in a property the claimed compound shares with the prior art, can rebut *prima facie* obviousness. 'Evidence that a compound is unexpectedly superior in one of a spectrum of common properties . . . can be enough to rebut a *prima facie* case of obviousness.' No set number of examples of superiority is required. *In re Chupp*, 816 F.2d 643, 646, 2 USPQ2d 1437, 1439 (Fed. Cir. 1987)." (emphasis added)

The Examiner stated in the Advisory Action that "...comparison of compound VI or Levitt shows 85% and 80% damage to ALOMY as compare (sic) to 90% and 90% of compound EI of instant invention at 80 gAI/ha and 20 gAI/ha, which is not a superior result, as one would expect such variations in structure sensitive art. Similarly, against AMARE, compound VII of Shutter (sic) shows 100% and 80% damage vs. 100% and 100% of compound EI of instant invention at 80 gAI/ha and 20 gAI/ha". This statement is objected to on two grounds:

- (1) While one unexpected property could be the improved activity against a specific weed, another unexpected property can be the overall effect against a spectrum of weeds, i.e. it is irrelevant that the Examiner finds the effect against ALOMY for compound E I in relation to compound VI to be an expected variation (which is not conceded by the applicants) or likewise with AMARE and compound VII because the data as a whole shows unexpected properties for compound E I as a broad spectrum agent and that lesser amounts of compound EI can be used to achieve the same effect on weeds.

One of ordinary skill in the art would clearly recognize that compound E I at 80 gAI/ha unexpectedly has better activity against ALOMY, AVEFA and AMARE as compared to compound VI (which has lesser effectiveness against all three weeds) or compound VII (which is less effective against ALOMY and AVEFA). One of ordinary skill in the art would also clearly recognize that the compound E I maintains its properties despite a 4-fold decrease in concentration. Similar decreases in concentration for compounds VI and VII results in significantly decreased activity.

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The Examiner appears to be misreading MPEP 716.02(a) as necessitating that all properties of the compound in question be unexpected including the observed properties recited by the Examiner. It is just the opposite. **Any property** which can be shown to be unexpected can be sufficient to rebut the *prima facie* case of obviousness. Here the applicants have clearly shown at least two unexpected properties: (a) simultaneously improved activity against ALOMY; AVEFA and AMARE; and (b) maintaining the activity at lower concentrations. As of this point in the prosecution, the Examiner has not provided any evidence which rebuts the applicants disclosure of unexpected properties regarding (a) and (b).

- (2) There is no supporting evidence for the Examiner's opinion regarding "expecting such variations". If the Examiner intended to take official notice with that statement (MPEP 2144.03), the applicants hereby request that the Examiner provide evidence in support of that statement which is relevant to fact specific situation regarding the compounds of formula (I) ("Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *In re Lee*, 277 F.3d at 1344-1345, 61 USPQ2d at 1434-1435 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697...", see MPEP 2144.03, section B.).
- (3) There is no supporting evidence for the Examiner's opinion that "one trained in the art would be motivated, in view of the activity of these compounds towards these weeds, to make the compounds taught by these prior art with varying substituents on the phenyl ring."

The relationship between the prior art and the claims is one of genus-species with the potential genus representing a virtually infinite number of permutations. It is not sufficient for the Examiner to allege that since the compounds are expected to have similar properties, all of the compounds are envisioned and that one of ordinary skill in the art would be motivated to make all of the compounds encompassed by the prior art. It has previously been held that "...the board said, referring to the appellant's ingredients, 'It should be noted that an infinite number of combinations is possible.' Accepting that as

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an approximation to the truth, we fail to see the obviousness in devising appellant's.....[invention] as claimed." *In re Rice*, 481 F.2d 1316, 1319, 178 USPQ 478, 480 (CCPA 1973).

For any of the reasons cited above, the applicants believe that the declarations of Dr. Menne establish evidence of unexpected results and that these unexpected results are sufficient to rebut the holding of *prima facie* obviousness.

Respectfully submitted,

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Attachments: Copy of Declaration by Dr. Hubert Menne (dated 20 November 2001)  
Copy of Declaration by Dr. Hubert Menne (dated 4 September 2002)